

**DOCKET NO.:** MSFT-3501/300585.03  
**Application No.:** 10/786,313  
**Office Action Dated:** October 29, 2008

**PATENT**

## **REMARKS**

This is a full and timely response to the non-final Office Action mailed October 29, 2008. Reconsideration and allowance of the application and presently pending claims are respectfully requested.

### **Telephone Conversation With Examiner**

Examiner Recek and Supervisor Caldwell are thanked for the telephone conversation conducted on January 13, 2009. Proposed claim amendments were discussed. Cited art was discussed. At least the proposed amendments to claims 1 and 19 appear to overcome the rejections based on the cited art. No agreements were reached.

### **Present Status of Patent Application**

Claims 1, 3-17, and 19-56 are currently pending. Of these pending claims, claims 4, 5, 7-10, 13, 17, 34-43, and 45-48 are original claims; claims 1, 19, 33, 44, and 49 have been currently amended without introduction of new matter; claims 3, 6, 11, 12, 14-16, 20-32, and 50-56 have been previously presented; and claims 2 and 18 remain canceled without prejudice, waiver, or disclaimer. Reconsideration and allowance of the application and presently pending claims are respectfully requested.

### **Claim Rejections under 35 U.S.C. §101**

#### **Statement of the Rejection**

*Claims 44-48 are rejected under 35 U.S.C. 101 because the claimed invention is directed to non-statutory subject matter.*

*Regarding claim 44, it is nominally directed to a device (machine) however no physical elements are present in the claim. Claim 49 indicates that all of the limitations can be performed by executable modules (software). Since there are no physical elements in the claim, the scope of the claim covers an embodiment that consists entirely of software. Software per se is not*

*patentable. Thus, the claim does not constitute one of the four statutory categories of invention as provided by 35 U.S.C. 101.*

### **Response to the Rejection**

Applicants respectfully traverse the rejection of claims 44-48 under 35 U.S.C. 101 for several reasons, a few of which are listed below:

- 1) It is admitted in the Office action that the claims are indeed directed to a device. However, the significance of this fact appears to have been either overlooked or misunderstood when assessing the statutory aspects of claims 44-48.
- 2) The claims include several “means” elements that cannot be legally dismissed as being “*entirely software*.” To the contrary, the use of the term “means” as an element of a claim clearly encompasses hardware and/or software.
- 3) The claims recite several useful and tangible results, thereby making the subject matter statutory and consequently ineligible for rejection under 35 U.S.C. 101.

Further remarks elaborating upon these topics are provided below.

### **Claim 44**

With reference to item 1) listed above, Applicants draw attention to page 4 of the Office action wherein it is alleged: “*Regarding claim 44, it is nominally directed to a device (machine) however no physical elements are present in the claim.*”

Applicants respectfully submit that this allegation is improper because it may be based on an inadequate interpretation of claim 44, in that the preamble has been dismissed as irrelevant and the various claim elements evaluated in isolation and out of context. Clearly, such an evaluation is improper and runs counter to MPEP 2106 II. C. at p. 2100-8, which states: “[W]hen evaluating the scope of a claim, every limitation in the claim must be considered. USPTO personnel may not dissect a claimed invention into discrete elements and then evaluate the elements in isolation. Instead, the claim as a whole must be considered.”

Applicants acknowledge that the term “computing device” is indeed recited in the preamble of claim 44 rather than in the body of the claim. However, in accordance with case law, it must be noted that: “[The preamble] *is not ignored in determining whether the subject*

*matter as a whole is statutory, for all of the claim steps are in implementation of th[e] method [recited in the preamble].” Arrhythmia Research Tech., Inc. v. Corazonix Corp., 958 F.2d 1053, 1059 (Fed. Cir. 1992).*

Therefore, Applicants respectfully submit that it is improper on the part of the Office action to dismiss the cited “device” aspect of claim 44 and inappropriately allege that “*no physical elements are present in the claim.*”

Turning now to item 2) listed above, claim 44 is directed at a computing device comprising several “*means for ...*” elements that perform specific functions. The phrase “*means for*” clearly encompasses hardware or a combination of hardware and software that can actually accomplish the function described after “*means for.*” Applicants are not obligated to restrict their claims to one or the other. Functionality carried out by a “*computing device,*” whether strictly by hardware or by a combination of hardware and software, is clearly patentable. Consequently, it is respectfully submitted that the rejection of claim 44 may be based on a misinterpretation of the term “*means for*” vis-à-vis law pertaining to 35 U.S.C. § 101.

With reference to item 3) listed above, it is respectfully asserted that only a claim which is totally incapable of producing a useful result (such as one that is totally abstract without any tangible limitation), can support a rejection under 35 U.S.C. 101. All it takes is a simple tangible limitation such as “computing device” to make a claim statutory. In this case, Applicants’ claim 44 not only recites tangible limitations (e.g., “computing device” and “means for...”), but also recites various tangible and useful results. For example, claim 44 includes tangible results such as: “*displaying on said computing device said content including both said public content and said private content,*” and “*...said content is rendered on the at least one alternate display device.*”

Furthermore, in the context of the tangible results cited in claim 44, it may be pertinent to draw attention to MPEP 2107.02 II. B. at p. 2100-29, which states: “*If an invention has a well-established utility, rejections under 35 U.S.C. 101 and 35 U.S.C. 112, first paragraph, based on lack of utility should not be imposed. . . . For example, if an application teaches [an aspect of] a well-known [subject], and those skilled in the art at the time of filing knew that [the subject] had*

*a well-established use, it would be improper to reject the claimed invention as lacking utility solely because of [a perceived] omitted statement of specific and substantial utility.”*

In summary, for at least the reasons described above, Applicants respectfully submit that the rejection of claim 44 under 35 U.S.C. 101 is improper and hereby request withdrawal of the rejection. It is further requested that the rejection of dependent claims 45-48 under 35 U.S.C. 101 be withdrawn as well.

### **Claim Rejections under 35 U.S.C. §103**

#### **I. Statement of the Rejection**

*Claims 1 and 3-5 are rejected under 35 U.S.C. 103(a) as being unpatentable over Acharya et al. US 2005/0036509 A1 in view of Parsons, Jr. et al. US 6,349,337 B1.*

#### **Response to the Rejection**

##### **Claim 1**

Applicants respectfully traverse the rejection of claim 1 under 35 U.S.C. 103 for various reasons some of which are described below. Notwithstanding the traversal, Applicants have opted to currently amend the claim in an effort to move forward prosecution in the case. The amended claim now includes various method steps associated with establishing a remote session, including the generation of a ticket by a sender device. The ticket provides information on “a) *how to connect to the sender device and b) which one amongst a plurality of projection modes is to be used.*” Further particulars pertaining to such a ticket have been described in various parts of Applicants’ original specification, for example in paragraphs [0105] and [0106].

In the matter of Applicants’ ticket, it may be pertinent to draw attention to page 5 of the current Office action wherein it is alleged: “*Acharya and Parsons do not explicitly disclose "the establishing comprising generation of a ticket that provides information on how to connect to the sender device" however such a feature is well known in the art. One example is KERBEROS authentication. It would have been obvious to one of ordinary skill in the art at the time of the invention to modify Acharya and Parsons with the generation of a ticket for connection / authentication.*” Applicants respectfully traverse this allegation for at least the following two

reasons:

- 1) Contrary to the rejection statement on page 4 of the Office action, wherein it is stated that claim 1 has been rejected using the combination of Acharya and Parsons, the allegation on page 5 clearly admits that these cited references do not disclose Applicants' ticket. However, for purposes of carrying out the rejection, this shortcoming has been apparently addressed by interjecting an unsubstantiated conclusory statement pertaining to the ticket ("*such a feature is well known in the art*"), thereby leading Applicants to conclude that the rejection has been carried out using Acharya, Parsons, and the unsubstantiated conclusory statement.
- 2) Because the Office action fails to show a valid teaching of Applicants' ticket in the cited references of Acharya and Parsons, it would appear that the unsubstantiated conclusory statement may be based on facts within the personal knowledge of the Examiner. If this is indeed the case, Applicants respectfully request an affidavit from Examiner in accordance with 37 CFR 1.104 (d) (2).

Turning now to the subject of "KERBEROS authentication" that has been cited in page 5 of the Office action, it may be pertinent to point out that a proper rejection of claim 1 necessitates not merely the identification of an authentication protocol such as KERBEROS (which allows individuals communicating over a non-secure network to prove their identity to one another in a secure manner), but one that incorporates a ticket that is used not only to provide information on "*how to connect to the sender device*" (as cited in rejected claim 1) but also to provide information on "*which one amongst a plurality of projection modes is to be used*" (as cited in currently amended claim 1).

It may be further pertinent to point out that, as currently amended, Applicants' "ticket" is generated in the sender device after the sender device receives "*a service document of the at least one alternate display device.*"

In light of the remarks above, Applicants respectfully submit that claim 1, at least in amended form, is clearly allowable over the cited references. Furthermore, Applicants respectfully submit that the current rejection of claim 1 is improper and inadequate for reasons

described above. Consequently, Applicants hereby request withdrawal of the rejection under 35 U.S.C. 103, followed by allowance of the claim.

**Claims 3-5**

Applicants respectfully submit that claims 3-5 are allowable for several reasons. One among these several reasons arises from the fact that these claims are each dependent on claim 1, which is allowable based on arguments presented above, thereby making claims 3-5 allowable by law. Applicants respectfully request withdrawal of the rejection followed by allowance of these claims.

**II. Statement of the Rejection**

*Claims 6, 10, 13-17, 19-31 and 49-56 are rejected under 35 U.S.C. 103(a) as being unpatentable over Acharya and Parsons, Jr. as applied to claim 1 above, and further in view of Masumoto et al. US 6,943,752 B2.*

**Response to the Rejection**

**Claims 6, 10, and 13-17**

Applicants respectfully submit that claims 6, 10, 13-17 are allowable for several reasons. One among these several reasons arises from the fact that these claims are each dependent on claim 1, which is allowable for reasons provided above. Consequently, claims 3-5 are also allowable by law arising from claim dependency. Therefore, Applicants respectfully request withdrawal of the rejection followed by allowance of these claims.

**Claim 19**

The Office action rejects claim 19 under 35 U.S.C. 103(a) by alleging that this claim contains similar limitations as claim 1. Applicants respectfully traverse this allegation.

Notwithstanding the traversal, Applicants have opted to currently amend claim 19 in order to move forward prosecution in the case. As a result, the claim now recites various additional method steps associated with establishing a remote session, including the generation of a ticket by a sender device. As recited in the amended claim, the ticket provides information on “a) how to connect to the computing device and b) which one amongst a plurality of

*projection modes is to be used.*” In this context, several remarks made above in response to the rejection of claim 1 are equally pertinent to the rejection of claim 19 as well. In the interests of brevity these remarks will not be repeated herein.

In summary, Applicants respectfully submit that claim 19, at least in amended form, is allowable over the cited references, and hereby request withdrawal of the rejection under 35 U.S.C. 103, followed by allowance of the claim.

### **Claims 20-31**

Applicants respectfully traverse the rejection of claims 20-32 for several reasons. For example, several claims have been rejected based on unsubstantiated conclusions drawn from the cited references (e.g., claims 22, 24, and 25 vis-à-vis PDA, and KERBEROS). With reference to claims 22 and 25, as alleged in the Office action, the cited portions of Acharya (paragraphs 6 and 7) do indeed mention a PDA. However, in contrast to the actual teachings of these paragraphs, the Office action inappropriately asserts that the paragraphs disclose various functionalities that are cited in Applicants’ claims (e.g. “*printing said at least one public portion to a journal*” of claim 22; and “*available for discovery state*” of claim 25).

In this matter, attention is drawn to MPEP 2131.01 (*II. To Explain the Meaning of a Term Used in the Primary Reference*), which states: Extrinsic evidence may be used to explain but not expand the meaning of terms and phrases used in the reference relied upon as anticipatory of the claimed subject matter. *In re Baxter Travenol Labs.*, 952 F.2d 388, 21 USPQ2d 1281 (Fed. Cir. 1991) (Emphasis added).

If the conclusions referred to above, are being drawn based on facts within the personal knowledge of the Examiner, Applicants respectfully request an affidavit from Examiner in accordance with 37 CFR 1.104 (d) (2).

Turning now to claim 31, it is alleged that the claim “*is a medium claim that corresponds to the method claim 15.*” This is clearly not the case as the cited claims 31 and 15 contain different material.

Notwithstanding the improprieties identified above, Applicants respectfully submit that

claims 20-31 are allowable by law arising from claim dependency on allowable claim 19. Therefore, Applicants respectfully request withdrawal of the rejection followed by allowance of these claims.

**Claim 49**

The Office action rejects claim 49 under 35 U.S.C. 103(a) by alleging that the claim corresponds to claim 19. Applicants respectfully traverse this allegation. However, Applicants have opted to currently amend claim 49 in order to move forward prosecution in the case. As a result, claim 49 now includes: *“means for discovering the at least one client display device by receiving a wireless “available for discovery” signal transmitted by the at least one client display device, wherein the wireless “available for discovery” signal is transmitted by the at least one client display device only when the at least one client display device is placed in an “allow others to project” state to enable receiving of projected content;”*

Applicants have described this aspect in various portions of their specification, for example in their paragraph [0111]. Amended claim 49 further clarifies that the “available for discovery signal” relates to an “allow others to project state” for projecting content on to a display device (client display device). Such a feature is not reasonably taught or disclosed, individually or combinedly, in the cited art. Consequently, Applicants respectfully submit that claim 49 is allowable and hereby request withdrawal of the rejection followed by allowance of this claim.

It may be further pertinent to draw attention to page 11 of the Office action wherein it is alleged that Acharya discloses (in his paragraph 7) *“a wireless available for discovery signal” as PDAs have such a feature.*” Applicants reiterate remarks made above with reference to unsubstantiated conclusions (*“as PDAs have such a feature”*) and refrain from repeating these remarks.

**Claims 50-56**

Applicants respectfully traverse the Office action allegation that claims 50-56 are substantially similar to claims 20-21, 23-24 and 27-29 and are therefore rejected for the same reasons. The Office action fails to provide a proper justification for such an allegation.



Notwithstanding the impropriety of the rejection, Applicants respectfully submit that claims 50-56 are allowable for several reasons. One among these several reasons arises from the fact that these claims are each dependent on claim 49, which is allowable for reasons provided above. Consequently, claims 50-56 are also allowable by law arising from claim dependency. Therefore, Applicants respectfully request withdrawal of the rejection followed by allowance of these claims.

## **II. Statement of the Rejection**

*Claims 7-9 are rejected under 35 U.S.C. 103(a) as being unpatentable over Acharya, Parsons and Masumoto in view of Orfitelli et al. U.S. 6,904,451 B1.*

### **Response to the Rejection**

#### **Claims 7-9**

Applicants respectfully assert that claims 7-9 are at least allowable due to their indirect dependency from allowable claim 1. Consequently, Applicants respectfully request withdrawal of the rejection followed by allowance of these claims.

## **III. Statement of the Rejection**

*Claims 11-12 and 32 are rejected under 35 U.S.C. 103(a) as being unpatentable over Masumoto, Parsons and Acharya in view of Zhang et al. "Software Solution to Completely Wireless Presentation" 2001.*

### **Response to the Rejection**

#### **Claims 11-12 and 32**

Applicants respectfully assert that claims 11-12 and 32 are at least allowable due to their indirect dependency from allowable claims 1 and 19 respectively. Consequently, Applicants respectfully request withdrawal of the rejection followed by allowance of these claims.

## **IV. Statement of the Rejection**

*Claims 33-48 are rejected under 35 U.S.C. 103(a) as being unpatentable over Zhang in*

*view of Masumoto and in view of Parsons Jr. and Acharya.*

### **Response to the Rejection**

#### **Claim 33**

Applicants respectfully traverse the rejection as well as the reasons provided in the Office action for combining the cited art. However, Applicants have opted to currently amend claim 33 in order to move forward prosecution in the case. As a result, claim 33 now means for discovering the at least one client display device by receiving a wireless *“available for discovery” signal transmitted by the at least one client display device, wherein the wireless “available for discovery” signal is transmitted by the at least one client display device only when the at least one client display device is placed in an “allow others to project” state to enable receiving of projected content.”*

Applicants have described this aspect in various portions of their specification, for example in their paragraph [0111]. Such a feature is not reasonably taught or disclosed, individually or combinedly, in the cited art. Consequently, Applicants respectfully submit that claim 33 is allowable and hereby request withdrawal of the rejection followed by allowance of this claim.

It may be further pertinent to draw attention to page 16 of the Office action wherein it is alleged that Acharya discloses: *“a wireless available for discovery signal” however this is taught by Acharya as using PDAs which have this capability (paragraph 7).”* Applicants reiterate remarks made above with reference to unsubstantiated conclusions (vis-à-vis *“as using PDAs which have this capability”*).

#### **Claims 34-43**

Applicants respectfully traverse the rejection of these claims as well as the reasons provided in the Office action for combining the cited art. Nonetheless, Applicants respectfully submit that claims 34-43 are allowable at least allowable due to claim dependency from allowable claim 33. Therefore, Applicants respectfully request withdrawal of the rejection followed by allowance of these claims.

#### **Claim 44**

Applicants respectfully traverse the rejection as well as the reasons provided in the Office action for combining the cited art. However, Applicants have opted to currently amend claim 44 in order to move forward prosecution in the case. As a result, claim 44 now includes: *“means for discovering the at least one client display device by receiving a wireless “available for discovery” signal transmitted by the at least one alternate display device, wherein the wireless “available for discovery” signal is transmitted by the at least one alternate display device only when the at least one alternate display device is placed in an “allow others to project” state to enable receiving of projected content.”*

Such a feature is not reasonably taught or disclosed, individually or combinedly, in the cited references. Consequently, Applicants respectfully submit that claim 44 is allowable and hereby request withdrawal of the rejection followed by allowance of this claim.

#### **Claims 45-48**

Applicants respectfully traverse the Office action allegation that claims 45-48 are substantially similar to claims 36-37, 40 and 43 and are therefore rejected for the same reasons. The Office action fails to provide a proper justification for such an allegation.

Notwithstanding the impropriety of the rejection, Applicants respectfully submit that claims 45-48 are allowable for several reasons. One among these several reasons arises from the fact that these claims are each dependent on claim 44, which is allowable for reasons provided above. Consequently, claims 45-48 are also allowable by law arising from claim dependency. Therefore, Applicants respectfully request withdrawal of the rejection followed by allowance of these claims.

#### **Cited Art Made of Record**

The cited art made of record has been considered, but is not believed to affect the patentability of the presently pending claims.

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### **CONCLUSION**

Applicant respectfully submits that pending claims 1, 3-17, and 19-56 are allowable. Favorable reconsideration and allowance of the present application and all pending claims are hereby courteously requested. If, in the opinion of the Examiner, a telephonic conference would expedite the examination of this matter, the Examiner is invited to call the undersigned representative.

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